

Attorney's Docket: 2002DE123  
Serial No.: 10/523,536  
Art Unit 1795  
Response to Office Action Mailed 04/15/2008

### REMARKS

The Office Action mailed August 16, 2007 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Applicant has amended the claims to attend to housekeeping matters and to more clearly describe the invention. Claims 13, 14, 19, 20 and 21 have been canceled. Claim 5 was amended to properly depend from claim 1. It is believed that no new matter has been introduced by this amendment.

The objection to claim 5 for informalities should be withdrawn in view of Applicant's amendment which amended the claim to properly depend from claim 1.

Claims 1, 3, 5-6, 8, 10-11, 15-17 and 22-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,118 to Macholdt et al. in view of US Patent No. 5360859 to Ogawa et al. The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,188 (the '118 Patent) to Macholdt et al. in view of US Patent No. 5360859 (the '859 Patent) to Ogawa et al. should be withdrawn for the reason that the '118 Patent requires a polyester moiety and is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A, and the '859 Patent teaches away from Applicant's use of double layered Mg/Al hydroxide salts and relates to the field of stabilizing resins and is silent on any method for controlling the charge of an electrophotographic toner. Macholdt et al. in the '118 Patent discloses a process for controlling the charge of an electrophotographic toner

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wherein the charge control agent is a polymer salt whose anionic component is a polyester (See col. 5, lines 5-7). The polyester of the '118 Patent, however, comprises the reaction product of the individual components: a) dicarboxylic acid, b) sulfo acid, c) a divalent alcohol = diol, d) optionally polyfunctional compound, and e) optionally a monocarboxylic acid. (See col. 5, lines 25-40). It is respectfully submitted that the salts of the instant invention do not comprise a polyester moiety. The dicarboxylic acid mentioned by the Examiner is not reacted to a polyester because there is no diol component present. The present claim language "comprising one or more organic anions X - R - Y" clearly distinguishes from "polyester salts comprising the reaction products of such anions with diols etc" as a polyester is no longer an organic anion of the formula X - R - Y. It is further respectfully submitted that a polyester has substantially different properties than a dicarboxylic acid. Ogawa does not teach that a hydrotalcite having Mg:Al ratio from 2-2.5 has the best heat stabilizing action (See col. 2, line 15-16). The entire passage reads:

*"We have also found that this lithium aluminum complex hydroxide salt has better heat stability than the hydrotalcite having a Mg:Al ratio from 2-2.5 ..."*

Thus, Ogawa teaches to use lithium aluminum salt instead of Mg Al salt. This clearly teaches away from the present invention. Therefore, no one skilled in the art would be led to make the claimed combination in view of the teachings of Ogawa which clearly teach away from Applicant's claimed combination. It is further respectfully submitted that Ogawa is nonanalogous art. Improving the heat stability of some resins is far away from the problem of applying a particular charge to the binder of an electrophotographic toner. Furthermore, Ogawa is silent on any electric charge. Clearly, no one skilled in the art armed with either the '118 Patent or the '859 Patent would have any teaching or suggestion to arrive at Applicant's invention without the use of improper hindsight. Applicant's claim 1 is directed to a process for controlling the charge of an electrophotographic toner which has a structure different from a polyester and no one

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skilled in the art charged with solving the problem of Applicant would find any teaching or suggestion to arrive at Applicant's process. Therefore, the rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,188 (the '118 Patent) to Macholdt et al. in view of US Patent No. 5360859 (the '859 Patent) to Ogawa et al. should be withdrawn for the reason that the '118 Patent requires a polyester moiety and is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A, and the '859 Patent teaches away from Applicant's use of double layered Mg/Al hydroxide salts and relates to the field of stabilizing resins and is silent on any method for controlling the charge of an electrophotographic toner.

The rejection of claims 3, 5-6, 8, 10-11, 15-17 and 22-24 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,502,188 (the '118 Patent) to Macholdt et al. in view of US Patent No. 5360859 (the '859 Patent) to Ogawa et al. should be withdrawn for the reasons given in support of claim 1 from which they depend.

Claims 9, 12 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. (US Pat. No. 5,502,118) (herein after referred to as "the '118 Patent") as applied to claim 1 above, and further in view of US Patent PGPub 20030215731, Saiki et al. (hereinafter as the '731 Publication). The rejection of claim 9, under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. (US Pat. No. 5,502,118) as applied to claim 1 above, and further in view of US Patent PGPub 20030215731, Saiki et al. should be withdrawn for the reason that the '118 as discussed hereinabove requires a polyester moiety and fails to teach that the salt is in the form of a hydrotalcite, and no combination of the '118 Patent and the '731 Publication can be made because the **'731 Publication is not prior art to the instant application**. Attached to Applicant's response filed 8 January 2008 was a certified copy of **Applicant's priority document DE10235571.1, having a filing date of 2002-August 03**, and a certified translation of the priority document. Applicant claims the priority date of Applicant's parent application DE10235571. Applicant's claimed priority

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date for parent document DE10235571.1 is earlier than the publication of the either the US publication date of the Saki et al. 20030215731 or the publication of the Japanese document 2003-162145A, published 2003.6.6. Therefore, the rejection of claims 9, 12 and 28 under 35 U.S.C. §103(a) as being unpatentable over Macholdt et al. (US Pat. No. 5,502,118) as applied to claim 1 above, and further in view of US Patent PGPub 20030215731, Saiki et al. is improper and should be withdrawn.

Claims 13, 14, 19, 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,728,366 to Martin et al. The rejection of claims 13-14 and 20-21 as amended under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,728,366 to Martin et al. is now moot in view of Applicant's cancellation of claims 13, 14, 20 and 21.

Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,



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